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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,498	07/15/2005	Seiji Morii	TIP-05-1194	5310

35811 7590 08/03/2007  
IP GROUP OF DLA PIPER US LLP  
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EXAMINER
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OH, TAYLOR V

ART UNIT	PAPER NUMBER
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1625

MAIL DATE	DELIVERY MODE
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08/03/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/542,498

**Applicant(s)**

MORII ET AL.

**Examiner**

Taylor Victor Oh

**Art Unit**

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/16/07 has been entered.

The Status of Claims:

Claims 1-30 are pending.

Claims 1-30 are rejected.

**DETAILED ACTION**

1. Claims 1-30 are under consideration in this Office Action.

**Priority**

2. It is noted that this application is a 371 of PCT/JP03/16474 (12/22/03), which has a foreign priority document, Japan 20038023 filed on 01/16/2003.

**Drawings**

3. None.

***Claim Objections***

Claims 1-30 are objected to because of the following informalities:

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Claims 1, 7, 8, 14, 20, and 26-30 have been newly amended to the original claims in order to introduce the phrases "about 90 % or more", "recovering about 90% or more of the optically active diacyltartaric acid" and "at least 94 %" into the claims. However, the newly introduced phrases are not literally present and shown in the original specification. What the only specification shows is in the followings : 98.0 %(Example 1), 96.8 %(Example 4), 94.0% (Example 6), 97.8% (Example 7), 94.3 % (Example 8), and 96.6 % (Example 9). A close inspection of the original claims and specification do not provide antecedent basis for the proposed changes. The corresponding new claim limitation to "at least 94 %" did not meet the description requirement because the phrase "at least" had no upper limit and caused the claim to read literally on embodiments outside the following values: 98.0 %(Example 1), 96.8 %(Example 4), 94.0% (Example 6), 97.8% (Example 7), 94.3 % (Example 8), and 96.6 % (Example 9). New matter can not be introduced into specification at any time during the prosecution, unless there is a supporting description that would support the proposed changes. Applicant is required to cancel the new matter in the reply to this Office Action.

**Claim Rejections - 35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claims 1, 7, 8, 14, 20, and 26-30, the phrases "about 90 % or more", "recovering about 90% or more of the optically active diacyltartaric acid" and " at least 94 % " are recited. However, these phrases have not been described in the original specification (see pages 9-15). Therefore, the addition of the new phrases "about 90 % or more", " recovering about 90% or more of the optically active diacyltartaric acid" and " at least 94 % " to the claims does not provide antecedent basis for the proposed changes. The newly introduced phrases are not literally present and shown in the original specification. What the only specification shows is in the followings : 98.0 %(Example 1), 96.8 %(Example 4), 94.0% (Example 6), 97.8% (Example 7), 94.3 % (Example 8), and 96.6 % (Example 9). A close inspection of the original claims and specification do not provide antecedent basis for the proposed changes. A corresponding new claim limitation to " at least 94 %" did not meet the description requirement because the phrase " at least" had no upper limit and caused the claim to read literally on embodiments outside the following values: 98.0 %(Example 1), 96.8 %(Example 4), 94.0% (Example 6), 97.8% (Example 7), 94.3 % (Example 8), and 96.6

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% (Example 9). New matter can not be introduced into specification at any time during the prosecution, unless there is a supporting description that would support the proposed changes. Applicant is required to cancel the new matter in the reply to this Office Action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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TAYLOR VICTOR OH  
PRIMARY EXAMINER

8/1/57